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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,658	02/07/2002	Tomoyuki Furuhashi	9319S-000328	3300

27572 7590 05/12/2004

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EXAMINER

PIZARRO CRESPO, MARCOS D

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/072,658

Applicant(s)

FURUHATA ET AL.

Examiner

Marcos D. Pizarro-Crespo

Art Unit

2814

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-11 and 22-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-11 and 22-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Application/Control Number: 10/072,658 (Non-Final Rejection)
Art Unit: 2814

Page 2

Attorney's Docket Number: 9319S-000328

Filing Date: 2/7/2002

Claimed Foreign Priority Date: 1/30/2002 (JP 2002-21025)
2/8/2001 (JP 2001-32069)

Applicant(s): Furuhashi et al.

Examiner: Marcos D. Pizarro-Crespo

DETAILED ACTION

This Office action responds to the amendment in paper no. 14 filed on 3/3/2004.

Continued Examination Under 37 CFR 1.114

1. A request for a continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after the final rejection in paper no. 13, mailed on 12/4/2003. Since this application is eligible for a continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/3/2004 has been entered.

Acknowledgment

2. The amendment in paper no. 14, filed on 3/3/2004, in response to the Office action in paper no. 13, mailed on 12/4/2003, has been entered. The present Office action is made with all the suggested amendments being fully considered. Accordingly, pending in this Office action are claims 1-11 and 22-25.

Drawings

3. Figure 18 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Initially, and with respect to claims 11 and 25, note that a "product by process" claim is directed to the product *per se*, no matter how actually made. See In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) and the related case law cited therein which makes it clear that it is the final product *per se* which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. As stated in Thorpe,

even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972); *In re Pilkington*, 411 F.2d 1345, 1348, 162 USPQ 145, 147 (CCPA 1969); *Buono v. Yankee Maid Dress Corp.*, 77 F.2d 274, 279, 26 USPQ 57, 61 (2d. Cir. 1935).

Note that Applicant has burden of proof in such cases, as the above case law makes clear.

8. Claims 8, 11, 22, and 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Goda (US2001/002713) in view of Machida (US5376590).

9. Regarding claims 8 and 22, Goda (see, e.g., fig. 27) shows most aspects of the instant invention including a semiconductor device having a non-volatile memory transistor formed on a semiconductor layer **11**, the semiconductor device comprising:

- ✓ An interlayer dielectric layer provided over the semiconductor layer **11** and the transistor with the dielectric layer being in direct contact with a component of the transistor, the dielectric layer including
 - A layer **21** containing nitride

- A second oxide film **17** provided on and in direct contact with the layer **21** containing nitride
- ✓ A wiring layer **18** provided on and in direct contact with the dielectric layer

Goda, however, fails to show a first oxide film provided as the lowermost layer of the dielectric layer such that the layer containing nitride is on and in direct contact with said first oxide film. Machida (see, e.g., col.16/ll.4-7), on the other hand, teaches that said first oxide film would protect Goda's device against contamination by mobile ions.

It would have been obvious at the time of the invention to one of ordinary skill in the art to provide a first oxide film as the lowermost layer of Goda's dielectric layer, as suggested by Machida, to protect the device against contamination by mobile ions.

10. Regarding claims 11 and 25, Machida (see, e.g., col.15/ll.66) shows that the first oxide film is an oxide layer formed by CVD. The method of specifically forming the oxide film by reduced pressure CVD using TEOS, is an intermediate process step that does not affect the structure of the final device. See MPEP § 2113, which discusses the handling of "product by process" claims.

11. Claims 9, 10, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goda/Machida in view of Wu (US 6008517).

12. Regarding claims 9, 10, 23, and 24, Goda/Machida shows most aspects of the instant invention (see paragraph 9 above), except for the oxide film having a thickness of 30-70 nm.

In spite of Goda/Machida not showing that the oxide film has a thickness of 30-70 nm, since the applicants have not established the criticality (see next paragraph) of the

film thickness and since these thicknesses are in common use in similar devices in the art (see, e.g., Wu/col.4/ll.16), it would have been obvious to one of ordinary skill in the art to use these values in the device of Goda/Machida.

CRITICALITY

13. The specification contains no disclosure of either the critical nature of the claimed arrangement or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen dimensions or upon another variable recited in a claim, the applicant must show that the chosen dimensions are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Response to Arguments

14. Applicant's arguments with respect to claims 8-11 and 22-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via Marcos.Pizarro@uspto.gov. If attempts to reach the

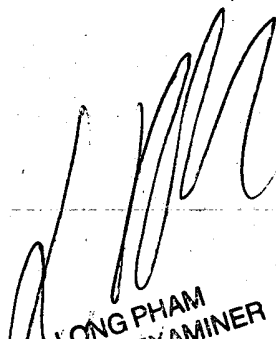
examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

17. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2814

18. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 257/632-651,758-760	5/5/2004
Other Documentation: PLUS Analysis	6/5/2003
Electronic Database(s): EAST (USPAT, EPO, JPO, PGPub)	5/5/2004


LONG PHAM
PRIMARY EXAMINER

Marcos D. Pizarro-Crespo

Patent Examiner

Art Unit 2814

571-272-1716

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